



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/581,447 | 04/12/2007 | Christian Funke | 2400/0450000/VLC | 2172 |

26111 7590 06/28/2011
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

| |
|----------|
| EXAMINER |
|----------|

MAEWALL, SNIGDHA

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1612

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

06/28/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|--------------------------------------|-------------------------------------|
| Office Action Summary | Application No. 10/581,447 | Applicant(s) FUNKE ET AL. |
| | Examiner SNIGDHA MAEWALL | Art Unit 1612 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>06/28/10</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|---|

DETAILED ACTION

1. Receipt of Applicants arguments/Remarks, IDS and **RCE** filed on 06/28/10 have been acknowledged.

Claims 1-11 remain cancelled.

Applicant had elected a composition with specific insecticide flonicamid from group 2 (2-6) and an anthranilamide of formula II (II-1) to be prosecuted.

Claims 15-16 do not read on the original elected species and thus are excluded from prosecution as being not elected by original presentation. Primicarb was not elected by original presentation; as such the claims drawn to Primicarb were not included in prosecution.

Claims **12-14** are under prosecution based on the originally elected species to be prosecuted.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable

Art Unit: 1612

over Lahm et al (WO 03/015518 A1, presented in IDS).

Applicants claim a synergistically effective composition containing a compound (I-a-4) of formula I or flonicamid (2-6) of group II and compound (II-1) of formula II.

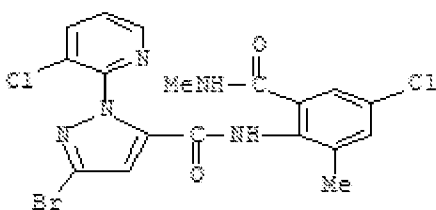
Lahm et al teach a method for controlling particular insect pests by applying their anthranilamide compounds. They also teach use of one or more other biologically active compounds or agents including insecticides, fungicides etc. including **flonicamid** (Page 96, lines 23-25 and 37).

The reference teaches anthranilamide derivative of following formula in their example 11 (Page 42, lines 18-20).

EXAMPLE 11

Preparation of 3-Bromo-N-{4-chloro-2-methyl-6-[(methylamino)carbonyl]phenyl}-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide

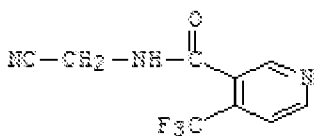
Corresponds to following structure



Lahm et al disclose use of one or more other biologically active compounds or agents including insecticides, fungicides etc. including **flonicamid** (Page 96, lines 23-25

Art Unit: 1612

and 37) of the following structure in their composition containing anthranilamide derivatives.



The reference teaches use of their compounds as a formulation or composition containing active ingredients 5-90 weight percent granules, tablets and powders. The reference does not specifically teach the ratio of individual active ingredient, it is the position of the Examiner that it will be at least a ratio of 1:1 (Page 89, line 18) and this includes compound of group 2 and anthranilamide of formula II ratio from 500:1 to 1:50 as claimed by instant claim 13. Additionally, optimization of amounts would be within the purview of a skilled artisan absent evidence of any criticality shown with the claimed amount. The reference teaches suitable carrier comprising a solid diluents or surfactant (Page 89, lines 1-3). The reference thus teaches use of composition containing anthranilamide derivatives, insecticide and a surfactant.

The specific combination of features claimed is disclosed within the broad generic ranges taught by the reference but such "picking and choosing" within several variables does not necessarily give rise to anticipation. Corning Glass Works v. Sumitomo Elec., 868 F.2d 1251, 1262 (Fed. Circ. 1989). Where, as here, the reference does not provide any motivation to select this specific combination of variables (various

Art Unit: 1612

insecticidal active compounds such as buprofezin, flonicamid and primicarb), anticipation cannot be found.

That being said, however, it must be remembered that “[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious”. KSR v. Teleflex, 127 S.Ct. 1727, 1740 (2007)(quoting Sakraida v. A.G. Pro, 425 U.S. 273, 282 (1976)). “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious”, the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” (Id.). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” KSR v. Teleflex, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that “[a] person of ordinary skill is... a person of ordinary creativity, not an automaton.” Id. at 1742.

Consistent with this reasoning, it would have obvious to have selected various combinations of various disclosed ingredients (various insecticidal active compounds such as buprofezin, flonicamid and primicarb) from within a prior art disclosure, to arrive compositions “yielding no more than one would expect from such an arrangement”.

Response to Arguments

Art Unit: 1612

4. Applicant's arguments filed 05/25/10 have been fully considered but they are not persuasive.

Applicant argues that Lahm covers long list of potential mixing partners for anthranilic acid amides whereas the instant claims are directed to narrow selection of synergistically effective compositions of anthranilic acid amides and four mixing partners only. Applicant then contends that Lahm does not teach synergistic composition of I-a-4 and at least one anthranilamide of formula (II-I). Applicant contends that no ratio has been cited in prior art for compounds and also the rejection is based on impermissible hindsight. Applicant's arguments are not persuasive. First applicants arguments are not persuasive with respect to the declaration provided to show synergism within the claimed compounds as insecticides because although the declaration provides unexpected results in terms of showing synergism in controlling animal pests with the combination of the claimed compounds, the unexpected results do not commensurate with the scope of the claims recited. Instant claim 12 does not recite any ratio and claim 13 recites very broad range for which there is not sufficient support for the broadest and the smallest range of ratio claimed between compounds of formula (I a-4 or (buprofezin, flonicamid, primicarb and anthranilamides of formula (II-I). Applicant is advised to amend the claims to reflect the ratios of the compounds for which synergistic results have been presented commensurate with the unexpected results provided in the declaration. The declaration is insufficient in providing synergistic unexpected results for insect control shown for the claimed compounds in its full scope.

Art Unit: 1612

More scientific and substantial data is required to be presented for the broad ratio of 500:1 claimed or the lowest range claimed.

Additionally, in response to applicants arguments that there was no motivation to mix any combination of compounds out of many from the prior art, the examiner repeats that "[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious". KSR v. Teleflex, 127 S.Ct. 1727, 1740 (2007)(quoting Sakraida v. A.G. Pro, 425 U.S. 273,282 (1976)). "[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious", the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." (Ida). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR v. Teleflex, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that "[a] person of ordinary skill is... a person of ordinary creativity, not an automaton." Idm at 1742.

Consistent with this reasoning, it would have obvious to have selected various combinations of various disclosed ingredients (various insecticidal active compounds such as buprofezin, flonicamid and primicarb) from within a prior art

Art Unit: 1612

disclosure, to arrive compositions "yielding no more than one would expect from such an arrangement". According to declaration the specific combination of compounds of claimed formula show synergistic results with specific ratio such as 1:25 or 1 : 1 or 1:625, no results have been shown for the broadly claimed ratio. In response to applicants assertion that Lahm does not show compound of formula I-a-4 at all, it is respectfully submitted that instant claim 12 provides combination of either compound of formula I-a-4 with anthranilamide or combination of (2-2), (2-6) or 2-7) with anthranilamide. Lahm makes obvious combination of anthranilamide with flonicamid, thus satisfies the claim limitations. In response to applicants assertions of the rejections based on impermissible hindsight, it is respectfully pointed out that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Snigdha Maewall whose telephone number is (571)-272-6197. The examiner can normally be reached on Monday to Friday; 8:30 a.m. to 5:00 p.m. EST.

Art Unit: 1612

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-0580. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Snigdha Maewall/

Examiner, Art Unit 1612

/Gollamudi S. Kishore/

Primary Examiner, Art Unit 1612